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## ***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

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<i>Group:</i>	3621	}	
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<i>Confirmation No.:</i>	6871	}	
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<i>Application No.:</i>	09/900,989	}	
		}	
<i>Invention:</i>	WASTE PROCESSING SYSTEM AND METHOD	}	FILED ELECTRONICALLY
		}	JANUARY 12, 2008
		}	
<i>Inventor:</i>	Kenneth S. Price et al.	}	
		}	
<i>Filed:</i>	July 9, 2001	}	
		}	
<i>Attorney</i>		}	
<i>Docket:</i>	41898-79395	}	
		}	
<i>Examiner:</i>	Chrystina E. Zelaskiewicz	}	

### REPLY BRIEF

#### **Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted electronically for the application identified above in response to the Examiner's Answer mailed November 10, 2008.

### ARGUMENT

The arguments of the Appeal Brief are reiterated here. The following analysis is in addition to the previous analysis provided. To the extent that the arguments in the Appeal Brief

rely on the lack of a teaching, suggestion, or motivation in the references, the arguments are modified as follows:

The Examiner has correctly noted that the Supreme Court has found that a teaching or motivation to combine two references does not have to be found in the references themselves. *KSR Int'l. Co. v. Teleflex, Inc. et al.*, 127 S.Ct. 1727 (2007). However, the Federal Circuit has clarified that absent a clear disclosure of the benefit in references, it is necessary that the benefit be identified in the knowledge and/or creativity of a person of ordinary skill in the art or some other objective evidence in order to make a prima facie finding of obviousness. *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, 86 USPQ2d 1196, 1201-1202 (Fed. Cir. 2008). Thus, it is incumbent on the Examiner to provide an identification of the objective evidence supporting a prima facie finding of obviousness.

The combination of Tipton and Embutsu is improper because the Examiner has failed to properly perform the factual inquiry as required under *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). In *KSR*, the Supreme Court clarified the test for obviousness. This decision has been codified for use by patent examiners throughout MPEP 2100. The Supreme Court in *KSR* reaffirmed that certain principles govern the analysis of obviousness. One principle reaffirmed in *KSR* is that the question of obviousness must be resolved on the basis of the factual inquiries enunciated by the Supreme Court in its landmark *Graham* decision. The first of such factual inquiries is a determination of the scope and content of the prior art. In support of the rejection, the Examiner did not fully evaluate the scope and content of Tipton and Embutsu.

Claim 22 recites “a first computer system configured to access the computer storage medium and stored waste management data and entity profile data, and further configured to

associate a set of vendors from the plurality of vendors to provide waste management service for the waste producing entity.” Tipton teaches an inventory management system that includes a contact management function which “includes contact personnel for any company that a division or department relies on for handling the disposal of their toxic waste.” (Tipton, col. 49, ll. 49-51) There is no disclosure of the specific capabilities of various toxic waste handlers being entered or stored in the database. In fact, the Examiner has acknowledged that “Tipton does not specifically disclose a matching mechanism within the database structure.” (Examiner’s Answer, page 4, lines 1-2). An object of Embutsu “is to provide an information management apparatus dealing With [sic] waste cable of supplying waste to meet the demand of *the waste recycling facility*.” (Embutsu, column 2, lines 6-9) Embutsu teaches a system which manages the flow of recyclable materials to a single waste recycling facility.

Contrary to the assertion of the Examiner in the Examiner’s Answer, Embutsu does not teach a computer system “configured to associate a set of vendors from the plurality of vendors to provide waste management service for the waste producing entity” as recited in claim 22. The Examiner confuses the “waste collecting agents” of Embutsu with “vendors having waste management capabilities” as recited claim 22. The waste collecting agents of Embutsu are simply “a number of trucks having a capacity of several tons.” (Embutsu, column 5, lines 25-26.) At best, Embutsu discloses a “collection method determination means” directed to determining the logistics for conveying discarded appliances to a single waste processing/recycling center.

While the Examiner relies on Embutsu to disclose the matching mechanism missing from Tipton, the matching mechanism is not disclosed in Embutsu because Embutsu does not disclose “a plurality of vendors having waste management capabilities” as recited in claim 22. To the

extent that the Examiner relies on Embutsu for the teaching of a computer system “configured to associate a set of vendors from *the plurality of vendors* to provide waste management service for the waste producing entity,” the Examiner has made a flawed analysis of Embutsu. Only in the Examiner’s Answer has the Examiner made the assertion that “waste collecting agents” (i.e. trucks) teach “a plurality of vendors having waste management capabilities.” The Examiner mischaracterizes the nature and capabilities of the waste collecting agents of Embutsu in the analysis. There is no disclosure in Embutsu that the collection agents have any “waste management capability” as understood in the art. One of ordinary skill in the art would not find the disclosure of collection agents operating trucks to teach or suggest a vendor having waste management capabilities. Embutsu is simply not directed to matching waste producing entities with waste management providers. Embutsu is a requirements planning system that “determines the waste collection method so that recycling products can be delivered stably” to a single recycling center. (Embutsu, abstract) Because the Examiner has failed to make a proper factual analysis of the scope and content of Embutsu, the combination of Tipton and Embutsu is improper and should be overruled for at least this reason.

The Examiner attempts to support the combination by selectively citing disparate statements in each of the references. However, the Examiner fails to provide any facts supporting the combination of the references. The Supreme Court in *KSR* held that when “determining whether claimed combination of elements known in prior art would have been obvious [examiners] will often be required to look to interrelated teachings of multiple patents, effects of demands known to design community or present in marketplace, and background knowledge of person of ordinary skill in art in order to determine whether there was apparent reason to combine known elements in manner claimed in patent in suit, and in order to facilitate

review, this analysis should be made explicit.” *KSR*, 1741. The *KSR* court emphasized the need for the examiner to engage in an *explicit analysis* of obviousness; as the Court stated: “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The Examiner has failed to make the explicit analysis for why a person of ordinary skill would combine the references. The Examiner makes the conclusory, and factually unsupported statement that “[a] ‘matching mechanism’ within the database structure would help institutions better address their needs.” (Examiner’s Answer, page 8, lines 24-25) While the Examiner lists several benefits of such a matching structure, there is no factual support or rational underpinning of why a “matching mechanism” would provide the noted benefits. Because the Examiner wholly fails to provide factual support for why a “matching mechanism” would provide the benefits listed, the combination of Tipton and Embutsu is improper and should be overruled for at least this reason.

The Supreme Court provided guidance to the analysis of obviousness in *KSR* in instructing that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR*, 1397. (emphasis in the original) The Court has previously explained “that the invention seems simple after it is made does not determine the question [of obviousness]; if this were the rule, many of the most beneficial patents would be stricken down.” *Loom Co. v. Higgins*, 105 U.S. 580, 591 (1881).

The Examiner appears to be using the instant application in hindsight to form the basis of support for the combination of the references. The Examiner has failed to provide an explicit analysis of factual support for the combination. Such a hindsight bias is improper and renders the

combination of Tipton and Embutsu as improper. The combination should be overruled for at least this reason.

The Examiner has mischaracterized the scope and content of Embutsu, failed to make a proper detailed factual inquiry supporting the combination, and the Examiner made a conclusory statement regarding the benefits of the combination, the Examiner appears to use hindsight bias to support the combination of Tipton and Embutsu. This flawed factual analysis cannot support a *prima facie* finding of obviousness. Because the Examiner has failed to undertake a proper factual analysis, the 35 U.S.C. §103(a) rejection of claims 22 and 49-50 as obvious over the combination of Tipton and Embutsu is improper. The rejection should be overruled for at least this reason.

Accordingly, it is submitted that the 35 U.S.C. §103 rejection of claims 22-42 and 49-52 is erroneous. The Board is thus urged to reverse the rejection. Such action is respectfully requested.

Respectfully submitted,

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